

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHRIS GREENER, DAVID BROGAN, LESLEY KAHN,
RON MESTER, BUD WERNER, ALEXIA MOORE,
and JACKIE SAPIR

Appeal 2008-0368
Application 09/678,430
Technology Center 2100

Decided: September 23, 2008

Before LANCE LEONARD BARRY, ALLEN R. MACDONALD, and
STEPHEN C. SIU, *Administrative Patent Judges*.

BARRY, *Administrative Patent Judge*:

DECISION ON APPEAL

I. STATEMENT OF THE CASE

A Patent Examiner rejected claim 33-40 and 42-60. The Appellants appeal therefrom under 35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6(b).

A. INVENTION

The invention at issue on appeal creates, designs, and deploys World Wide Web-based surveys in a host machine using a standard web browser without requiring the need of a survey creation program at the survey designer's computer. (Spec. 4.)

B. ILLUSTRATIVE CLAIM

Claim 47, which further illustrates the invention, follows.

47. A method comprising:

using a survey creation engine of a host computer through a survey design computer via a network to create a survey;

storing the survey on the host computer; and

using the survey design computer via the network to edit a list of e-mail recipients stored on the host computer and sending an e-mail to recipients designated in the list of e-mail recipients, the e-mail containing a network link to the host computer for client computers receiving the e-mail to access the survey stored on the host computer via network protocols other than mail protocols.

C. REJECTIONS

Claims 33-40, 42-46, and 56 stand rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent Application Pub. No. 2002/0128898 ("Smith") and U.S. Patent Application Pub. No. 2004/0169675 ("Beck").

Appeal 2008-0368
Application 09/678,430

Claims 47-55 and 57-60 stand rejected under § 103(a) as obvious over Smith, Beck, and U.S. Patent Application Pub. No. 2001/0052009 ("Desai").

"Rather than reiterate the positions of parties *in toto*, we focus on the issues therebetween." *Ex parte Katsukawa*, No. 2007-0732, 2007 WL 3043602 at *2 (BPAI 2007).

II. LIST OF E-MAIL RECIPIENTS

The Examiner makes the following findings.

Smith's survey conductor server [254] provides the means for the creation and management of surveys electronically in a manner synonymous to applicant's teachings of a survey creation engine and thus the teachings of both applicant's claim language and Smith are equivalent. Smith's Survey builder [294] defines an interface that is used to create various types of survey designs as illustrated in applicant's claim language regarding a survey design machine.

(Ans. 7.) The Appellants argue that "Smith and/or Beck alone or in combination do not teach or suggest . . . an e-mail list management facility configured to provide management capability through the network browser of the survey design machine of a list of e-mail recipients chosen to receive an e-mail . . . containing a network link to provide access to the survey for the client computer." (App. Br. 12.) Therefore, the issue is whether Smith would appear to have suggested providing a list of e-mail recipients chosen to receive an e-mail and sending the e-mail to the recipients.

The question of obviousness is "based on underlying factual determinations including . . . what th[e] prior art teaches explicitly and inherently . . ." *In re Zurko*, 258 F.3d 1379, 1383-84 (Fed. Cir. 2001) (citing *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966); *In re Dembicza*k, 175 F.3d 994, 998 (Fed. Cir. 1999); *In re Napier*, 55 F.3d 610, 613 (Fed. Cir. 1995)). "A *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." *In re Bell*, 991 F.2d 781, 783 (Fed. Cir. 1993) (quoting *In re Rinehart*, 531 F.2d 1048, 1051 (CCPA 1976)).

Here, Smith's "FIG. 6 illustrates a flow diagram for automating a survey over a network . . ." (¶ [0134].) "At step 606, the client selects a target group of network users who are to take and complete the survey." (¶ [0135].) The reference discloses that "a variety of mechanisms that may be used to send a message . . . to request participation in a survey. For example, request sources 702 may include . . . an email message 706 that has an embedded URL [i.e., uniform resource locator] associated with survey assigning server 716 . . ." (¶ [0146].) *See also* ¶ [0153] ("For example, by selecting . . . an embedded URL within an email 706 that is associated with survey assigning server 716, a participation request message may be sent to and received by access point 720.")

Because Smiths' client selects a target group of network users who are to take and complete the survey and the selected users are sent an email message having an embedded URL, we find that Smith would have

suggested providing a list of those users chosen to receive the email message. Therefore, we further find that Smith would appear to have suggested providing a list of e-mail recipients chosen to receive an e-mail and sending an e-mail to the recipients.

III. COMBINING TEACHINGS OF REFERENCES

The Examiner makes the following findings and conclusion.

It would have been obvious at the time of the invention for one of ordinary skill in the art to have combined the teachings of Smith and Beck, because using the steps of "the e-mail containing a network link to provide access to the survey for the client computer via network protocols . . ." would have given those skilled in the art the tools to provide survey data in the form of e-mail over a network. This give users the advantage of processing survey data faster.

...
It would have been obvious at the time of the invention for one of ordinary skill in the art the tools to efficiently edit email list for surveying purposes. This give users the advantage for rendering modified survey lists from recipients faster.

(Answer 4, 6.) The Appellants make the following arguments.

[T]he Office Action's suggestion to combine Smith in view of Beck is not found either explicitly and/or implicitly in Smith and/or Beck. Furthermore, there is no sworn affidavit by the Examiner found in the Office Action attesting to the veracity of the Examiner's personal expert knowledge of the level of understanding regarding the subject matter of one of ordinary skill in the art at the time of invention associated with issues of obviousness in forming the combination of Smith in view of Beck.

[T]he Office Action's suggestion to combine Smith in view of Beck and further in view of Desai is not found either explicitly and/or implicitly in Smith and/or Beck and/or Desai. In addition, there is no sworn affidavit by the Examiner found in the Office Action attesting to the veracity of the Examiner's personal expert knowledge of the level of understanding regarding the subject matter of one of ordinary skill in the art at the time of invention associated with issues of obviousness in forming the combination of Smith in view of Beck, further in view of Desai.

(App. Br. 12-14.) Therefore, the issue is whether the Appellants have shown error in the Examiner's reasons for combining teachings from Smith, Beck, or Desai.

The presence or absence of a reason "to combine references in an obviousness determination is a pure question of fact." *In re Gartside*, 203 F.3d 1305, 1316 (Fed. Cir. 2000) (citing *In re Dembicza*k, 175 F.3d 994, 1000 (Fed. Cir. 1999)). "The obviousness analysis cannot be confined by a formalistic conception of the words teaching, suggestion, and motivation, or by overemphasis on the importance of published articles and the explicit content of issued patents. The diversity of inventive pursuits and of modern technology counsels against limiting the analysis in this way." *KSR Int'l v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007). A reason to combine teachings from the prior art "may be found in explicit or implicit teachings within the references themselves, from the ordinary knowledge of those skilled in the art, or from the nature of the problem to be solved." *WMS Gaming Inc. v. Int'l Game Tech.*, 184 F.3d 1339, 1355 (Fed. Cir. 1999) (citing *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

Here, the argument that a reason to combine teachings from the references must be found either explicitly or implicitly therein is incorrect. Furthermore, we are unaware of any requirement for an affidavit by the Examiner attesting to the veracity of his personal expert knowledge of the level of understanding regarding the subject matter of one of ordinary skill in the art at the time of invention associated with issues of obviousness in forming the combination of references.

The Appellants have shown no error in the Examiner's reasons for combining teachings from Smith, Beck, or Desai. Therefore, we affirm the rejections of claims 33-40 and 42-54.

IV. UNADDRESSED LIMITATIONS

The Examiner finds that claims 55 and 58 "are rejected on grounds corresponding to the arguments given above for rejected claims 33 and 47 and are similarly rejected." (Ans. 6.) Observing that "claim 55 includes the survey creation engine being configured to provide to the network browser of the survey design machine at least one function to resize web content objects to be added during survey creation" (App. Br. 15) and that "claim 58 includes the survey creation engine being configured to provide to the network browser of the survey design machine at least one function to perform survey background design" (*id.* 16), the Appellants argue that they "could not find anywhere in Smith and/or Beck and/or Desai where this was suggested or taught . . . (*id.*)."⁷ Therefore, the issue is whether the Examiner has presented a *prima facie* case of obviousness.

"The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art." *In re Lowry*, 32 F.3d 1579, 1582 (Fed. Cir. 1994) (citing *In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983)). "In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness." *In re Rijckaert*, 9 F.3d 1531, 1532 (Fed. Cir. 1993) (citing *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992)).

Addressing neither claim 55's resizing of web content objects to be added during survey creation nor claim 58's performing of survey background design, the Examiner has not presented a *prima facie* case of obviousness. Therefore, we reverse the rejection of claims 55 and 58 and the rejection of claim 56, which depends from the former claim.

V. PROGRESS BARS

The Examiner finds that "Smith, JR. et al. teaches 'progress bars to be added by the survey creation engine' (see paragraph [0110], whereas Smith's gathering of results indicates a progress element in regards to surveying . . ." (Ans. 6-7.) The Appellants "do not believe the mere processing of results is similar to selecting progress bars . . ." (App. Br. 15-16.) Therefore, the issue is whether the Examiner has shown that Smith teaches or would have suggested a survey creation engine adding progress bars to a survey.

The paragraph of Smith relied on by the Examiner discloses that "[w]hen a survey is fielded to a particular target group, the results are gathered, processed, and analyzed to generate survey data that reflects the survey results." (¶ [0110].) For our part, we are unpersuaded that the mere gathering of results "indicates a progress element in regards to surveying . . ." (Answer 6-7.)

Furthermore, the Examiner does not allege, let alone show, that the addition of Beck or Desai cures the aforementioned deficiency of Smith. Absent a teaching or suggestion of a survey creation engine adding progress bars to a survey, we are unpersuaded of a *prima facie* case of obviousness. Therefore, we reverse the rejection of claim 57.

VI. FONT AND COLOR SCHEME

The Examiner finds that "Smith, JR et al. teaches 'select font of text . . . color . . .' (see fig. 3 . . .)" (Ans. 7.) The Appellants "could not find anywhere in Smith, including Figure 3 - sheet 4 of 11, and/or Beck and/or Desai where this was suggested or taught . . ." (App. Br. 17.) Therefore, the issue is whether the Examiner has shown that Smith teaches or would have suggested a survey creation engine selecting the font of text used in a survey or the color scheme of the survey.

Smith explains that its "FIG. 3 is an example of an interface page that can be used by the user to generate questions and responses in defining a survey . . ." (¶ [0031].) We see no options in the interface page for

selecting the font of text used in the survey or for selecting the color scheme of the survey.

Furthermore, the Examiner does not allege, let alone show, that the addition of Beck or Desai cures the aforementioned deficiency of Smith. Absent a teaching or suggestion of a survey creation engine electing the font of text used in a survey or the color scheme of the survey, we are unpersuaded of a *prima facie* case of obviousness. Therefore, we reverse the rejection of claims 59 and 60.

VII. ORDER

In summary, the rejections of claims 33-40 and 42-54 are affirmed, but the rejections of claims 55-60 are reversed.

"Any arguments or authorities not included in the brief or a reply brief filed pursuant to [37 C.F.R.] § 41.41 will be refused consideration by the Board, unless good cause is shown." 37 C.F.R. § 41.37(c)(1)(vii). Accordingly, our affirmance is based only on the arguments made in the *Appellant's* [sic] *Brief*. Any arguments or authorities omitted therefrom are neither before us nor at issue but are considered waived. Cf. *In re Watts*, 354 F.3d 1362, 1367 (Fed. Cir. 2004) ("[I]t is important that the applicant challenging a decision not be permitted to raise arguments on appeal that were not presented to the Board.")

Appeal 2008-0368
Application 09/678,430

No time for taking any action connected with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

rwk

DAVIS WRIGHT TREMAINE, LLP/Seattle
1201 Third Avenue, Suite 2200
SEATTLE WA 98101-3045